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10/559,489	05/08/2006	Juergen Hofmann	30882/DP031	1195

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EXAMINER	
ALLEN, WILLIAM J	
ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/559,489	HOFMANN ET AL.	
	Examiner	Art Unit	
	WILLIAM J. ALLEN	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-16 and 18-27* is/are rejected.

7)☒ Claim(s) *9 and 17* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/8/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Prosecution History Summary

Claims 1-27 have been amended per Applicant's amendment filed 5/8/2006.

Claims 1-8, 10-16, and 18-27 are rejected.

Claims 9 and 17 are objected to as being allowable as set forth below.

Claim Objections

Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Allowable Subject Matter

Claims 9 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 9 and 17 recite features which are not anticipated nor rendered obvious over the evidenced obtained throughout prosecution of the application. The combination of elements as recited in claims 9 and 17 would not have been obvious over the evidence at hand because any combination of the evidence at hand would only result from a substantial reconstruction of Applicant's claims using improper hindsight.

Moreover, regarding claim 17, Maxwell teaches the conversion of an email/web protocol using smtp protocol into a mail piece. The requirements of claim 17 oppose such features in Maxwell, claim 17 requiring the conversion from smtp to http (rather than http to smtp as demonstrated by Maxwell).

For at least the reasons above, claims 9 and 17 would be allowable if rewritten in independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 23 and dependent claims 25-27, claim 23 recites a single "means for" the automated ordering and performing of printing services and mailing services using the method of claim 1. Applicant's, however, has not properly invoked 112, 6th paragraph. Applicant's disclosure fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

More specifically, rather than a single means for facilitating automated ordering, Applicant's disclosure describes multiple "means for" providing the automated ordering (e.g. a mobile system, a mailing service system, a verification and processing component, etc.). It is thereby unclear how a single means for acts to comprise the lone structure of the system, and further, what structure actually comprises the claimed means for.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-7, 12-14, 16, 18-21, and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker (US 20030004997) in view of Maxwell (US 5805810).

Regarding claim 1, Parker teaches a method for the automated ordering and performing of printing services comprising:

generating order data by a mobile terminal, whereby the order data comprises at least one image motif and of delivery information in the form of a mailing address [see at least: 0011-0012, 0048-0050, 0057, 0072, 0080, Fig. 1(a)-5, Fig. 9(a)-(b), Fig. 10 #99];

transmitting the order data from the mobile terminal to a preparation component of the mobile system [see at least: Fig. 17, Fig. 13 #130, Fig. 14 #240, Fig. 15 #630, 0085],

transmitting the order data from the interface to a database [see at least: 0087, Fig. 17 #835],

editing the order data into a printing order in an editing component that is connected to the database [see at least: Fig. 17 #815, 0085],

transmitting the printing order to a printing production component [see at least: Fig. 17 #820, 0085],

generating mail in the printing production component [see at least: Fig. 17 #825-826, 0085-0086],

transferring the mail to a distribution system [see at least: Fig. 17 #826, 0010, 0086], and

invoicing for the printing service and/or mailing service via an invoicing component of the mailing service system, wherein the invoicing component of the mailing service system invoices an invoicing component of the mobile system for printing service and/or mailing service [see at least: Fig. 17 #810, 0080].

Though teaching all of the above, Parker does not teach: *transmitting the order data from the preparation component of the mobile system to a verification and processing component, checking and processing the order data in the verification and processing component and transmitting the order data to an interface of the mailing service system.*

In the same field of endeavor, Maxwell teaches *transmitting the order data from the preparation component of the mobile system to a verification and processing component, checking and processing the order data in the verification and processing component and transmitting the order data to an interface of the mailing service system* [see at least: col. 5 lines 49-60, Fig. 2 #22, col. 8 lines 23-32, col. 10 line 5-14].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Parker to have included the noted features as taught by Maxwell because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results.

Regarding claim 3, the combination teaches *wherein the image motif for an order is an image generated on the user side or an image from a selection offered him* [see at least: Parker, 0004-0006, 0011, 0025].

Regarding claim 4, the combination further teaches *wherein the mail to be printed and sent is a card having an image motif side and a text side* [see at least: Parker, Fig. 1(a) #4, Fig. 2-4]. Note: merely labeling a card different from the prior art (i.e. a *post*card v. a *greeting* card] does not move to distinguish the claimed invention from the prior art.

Regarding claim 5, the combination further teaches *transmitting the order data from one computer of the preparation component to the verification and processing component via a protocol that has been coordinated between the components* [see at least: Maxwell, col. 5 lines 49-60, Fig. 2 #21 and #22, col. 8 lines 23-32, col. 10 line 5-14]. Note: elements 21 and 22 of Fig. 2 are configured to communicate directly with one another.

Regarding claim 6, the combination further teaches *wherein the coordinated protocol is the smtp protocol* [see at least: Maxwell, col. 6 lines 18-20].

Regarding claim 7, the combination further teaches *filtering the received order data according to predefined specifications* [see at least: Maxwell, col. 5 lines 61-66, col. 10 lines 18-22].

Regarding claim 12, the combination further teaches *wherein the filtering comprises sorting out order data that does not contain defined characters and/or character strings* [see at least: Maxwell, col. 5 lines 61-66, col. 10 lines 18-22].

Regarding claim 13, the combination further teaches *wherein the verification and processing component carries out a validation of the received order data according to prescribed specifications* [see at least: Maxwell, col. 5 lines 49-60, Fig. 2 #21 and #22, col. 8 lines 23-32, col. 10 line 5-14].

Regarding claim 14, the combination further teaches *wherein the validation step comprises checking the syntax and/or the semantics of the delivery information* [see at least: Maxwell, col. 8 lines 23-47, col. 10 lines 5-14 and 15-33, col. 7 lines 28-31, Fig. 5 #560 and 570]..

Regarding claim 16, the combination further teaches *comprising the verification and processing component carrying out a conversion of the order data into data that can be read by the interface of the mailing service system* [see at least: Maxwell, col. 10 lines 43-49, col. 12 lines 38-43 and 55-67].

Regarding claim 18, the combination further teaches *comprising storing the order data processed by the verification and processing component in a database* [see at least: Maxwell, col. 10 lines 43-49, col. 12 lines 38-43]. Note: queue is analogous to database.

Regarding claim 19, the combination further teaches *storing the order data in the database, marking the order data as being erroneous, if said data is erroneous and/or cannot be corrected* [see at least: Maxwell, col. 10 lines 5-33, Fig., 8 #720].

Note: Though teaching the above, the Examiner further notes the recited "if" steps do not move to distinguish the claimed invention from the cited art. These phrases are conditional limitations with the noted "if" step not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: In re Johnston, 77 USPQ2d 1788 (CA FC 2006); Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C].

Regarding claim 20, the combination further teaches *storing the order data in the database, marking the order data as being erroneous* [see at least: Maxwell, col. 10 lines 5-33, Fig. 8 #720], and sending once again *if* an error occurred when the data was transmitted from the verification and processing component to the interface.

Also, see "Note" regarding claim 19.

Regarding claim 21, the combination further teaches *automatically transmitting a message to the user who has generated order data on a mobile terminal if the checking and processing of the order data reveals that the ordered mail cannot be printed and/or mailed* [see at least: col. 10 lines 23-27]. Also, see "Note" regarding claim 19.

Regarding claims 23 and 24, these claims closely parallel the limitations set forth in claim 1 and are thereby rejected for at least the same rationale.

Regarding claim 25, the combination further teaches where *the verification and processing component belongs to the mailing service system* [see at least: Maxwell, Fig. 2]. The combination, however, does not expressly teach where the component *belongs to the mobile system.* Such features, however, merely represent the rearrangement of parts and would be obvious to one of ordinary skill in the art because claims that read on prior art except with regard to the positioning and arrangement of parts are held unpatentable if the shifting of those parts would not have modified the operation of the device [*In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)].

Regarding claim 26, the combination further teaches where *the verification and processing component belongs to the mailing service system* [see at least: Maxwell, Fig. 2].

Regarding claim 27, the combination further teaches [see at least: Parker, 0011, 0048, 0083, 0086, Fig. 10 #100]. Note: web servers/sites and email use http protocol to transmit data over the internet.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of Maxwell as applied to claim 1 above, and further in view of Yang (US 20030065738).

Regarding claim 2, though teaching the use of a mobile device (e.g. PDA) for generating order data, Parker and Maxwell do not expressly teach where the generated order data *is present in the form of MMS data.*

In the field of mobile electronics and purchasing, Yang teaches where generated order data *is present in the form of MMS data* [see at least: 0041].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Parker and Maxwell to have included the noted features as taught by Yang because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results.

Claim 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of Maxwell as applied to claim 1 and 7 above, and further in view of Tackbary (US 5960412).

Regarding claim 8, Parker and Maxwell teach all of the above as note but do not expressly teach *wherein the filtering step comprises sorting out order data that was not sent by a computing means (94) of the mobile system (11) having a defined IP address*.

In the same field of endeavor, Tackbary teaches a system and method for ordering social expression cards [see at least: abstract]. More specifically, Tackbary teaches filtering the received order data according to predefined specifications (claim 7) *wherein the filtering step comprises sorting out order data that was not sent by a computing means (94) of the mobile system (11) having a defined IP address* (claim 8) [see at least: col. 12 lines 11-42, Fig. 11].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Parker and Maxwell to have included the noted features as taught by Tackbary because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, the incorporation of Tackbary would improve the system of Parker and Maxwell by allowing a user, having selected a number of cards, to send an order in a variety of ways (e.g. mail, facsimile, electronically) [see at least: Tackbary, col. 2 lines 36-40].

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of Maxwell as applied to claim 1 and 7 above, and further in view of Official Notice 1.

Regarding claim 10, Parker and Maxwell teach all of the above as noted including *filtering according to predefined criteria*. The combination, however, does not expressly teach *wherein the filtering step comprises sorting out order data containing unsolicited advertising and mass-mailing orders (spam data)*. The Examiner asserts that such features are old and well know in the art (e.g. filtering spam or erroneous orders) and thereby takes Official Notice to said features.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Parker and Maxwell to have included the noted features as taught by Official Notice 1 because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of Maxwell as applied to claim 1 and 7 above, and further in view of Christiansen (US 20040119997).

Regarding claim 11, Parker and Maxwell teach all of the above as noted including *filtering* (Maxwell). The combination, however, does not expressly teach *wherein the filtering comprises sorting out order data for which the transmitted file size does not match a defined size range*.

In the field of print processing, Christiansen teaches a system and method for organization image processing pipelines [see at least: abstract]. More specifically, Christiansen teaches *wherein the filtering comprises sorting out order data for which the transmitted file size does not match a defined size range* [see at least: 0042].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Parker and Maxwell to have included the noted features as taught by Christiansen because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of Maxwell as applied to claim 1 and 13 above, and further in view of Almeda (US 20030018723).

Regarding claim 15, the combination teaches all of the above as noted but does not expressly teach *wherein the validation comprises correcting the syntax and/or the semantics of the delivery information.*

In a related field of endeavor, Almeda teaches a method of managing the updating of email address [see at least: abstract]. More specifically, Almeda teaches *wherein validation comprises correcting the syntax and/or the semantics of the delivery information* [see at least: 0013, 0041].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Parker and Maxwell to have included the noted features as taught by Almeda because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, the incorporation of Almeda would result in an improved system and method, resulting in a time efficient system which manages changes in email address [see at least: Almeda, 0012-0013].

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of Maxwell as applied to claim 1 and 21 above, and further in view of Official Notice 2.

Regarding claim 10, Parker and Maxwell teach all of the above as noted including *filtering according to predefined criteria*. The combination, however, does not expressly teach *wherein a user of the mobile system is not invoiced or only partially invoiced for the ordered mail by the invoicing component of the mobile system if ordered mail cannot be printed and/or mailed*. The Examiner asserts that such features are old and well know in the art (e.g. not invoicing a customer for a service not rendered to the customer) and thereby takes Official Notice to said features.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Parker and Maxwell to have included the noted features as taught by Official Notice 2 because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 20010051876 A1 discloses a system and method for personalizing, customizing and distributing geographically distinctive products and travel information over the internet [note 0148, 0273-0274]
- US 20020103711 A1 discloses an online method and system for ordering and having delivered a paper greeting message and payment instrument [note 0032, 0057]
- US 5552994 A discloses a system for printing social expression cards in response to electronically transmitted orders [note abstract, Fig. 2]
- US 20040205138 A1 Method and apparatus for creation, personalization, and fulfillment of greeting cards with gift cards [note 0007, 0205, 0262, 0266-0270, 0277]

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. ALLEN whose telephone number is (571)272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
/William J Allen/
Examiner, Art Unit 3625